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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARCO GULDENAAR

Appeal 2015-003656
Application 13/078,196
Technology Center 3700

Before EDWARD A. BROWN, JILL D. HILL, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Marco Guldenaar (Appellant)¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–3, 5, 7–14, 16–18, and 23–30, which are the pending claims. We have jurisdiction under 35 U.S.C. § 6(b). We heard oral argument on June 12, 2017.

We AFFIRM.

¹ Marco Guldenaar Holding BV is identified as the real party in interest. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Appellant's invention "relates to casino games, and more particularly to dice games intended to be played in gambling casinos, in which a participant attempts to achieve a particular winning combination of subsets of the dice, relying on observations, luck, and bets driven by belief and personal betting strategies for each individual game." Spec. ¶ 29.

Claims 1, 11, and 23 are independent. Claim 1, reproduced below, illustrates the claimed subject matter.

1. A method of playing a dice game comprising:
 - providing a set of dice, the set of dice comprising a first die, a second die, and a third die, wherein only a single face of the first die has a first die marking, wherein only two faces of the second die have an identical second die marking, and wherein only three faces of the third die have an identical third die marking;
 - placing at least one wager on at least one of the following:
 - that the first die marking on the first die will appear face up, that the second die marking on the second die will appear face up, that the third die marking on the third die will appear face up, or any combination thereof;
 - rolling the set of dice; and
 - paying a payout amount if the at least one wager occurs.

Appeal Br. 19 (Claims App.).

REJECTIONS

Claims 1–3, 5, 7–14, 16–18, and 23–30 are rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.

Claims 1–3, 5, 7–14, 16–18, and 23–30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Carroll (US 4,247,114, issued Jan. 27, 1981) "in view of matters old and well known to dice games."

ANALYSIS

Rejection of claims 1–3, 5, 7–14, 16–18, and 23–30 under 35 U.S.C. § 101

Appellant argues claims 1–3, 5, 7–14, 16–18, and 23–30 together as a group (Appeal Br. 6–14), and additionally presents separate argument for claims 10, 18, 24, and 26 (*id.* at 14). We select claim 1 to decide the rejection of claims 1–3, 5, 7–9, 11–14, 16, 17, 23, 25, and 27–30, with claims 2, 3, 5, 7–9, 11–14, 16, 17, 23, 25, and 27–30 standing or falling with claim 1. We also address the separate argument for claims 10, 18, 24, and 26. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claims 1–3, 5, 7–9, 11–14, 16, 17, 23, 25, and 27–30

Claim 1 is directed to a method of playing a dice game. Hence, claim 1 falls within a statutory category. *See Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). The question then becomes whether the claim is directed to a judicial exception, such as an abstract idea.

The Examiner determines that claim 1 is drawn to an abstract idea, applying *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347 (2014). Ans. 2–3.² *Alice* provides “a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (*citing Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S.Ct. 1289 (2012)). According to this framework, it is first determined whether the claims at issue are directed to one of the judicial exceptions. *Id.* If not, the claims satisfy § 101. *Id.* Here, the Examiner determines that the claims are

² The Final Office Action is dated August 25, 2014, predating *Alice*.

directed toward “rules for playing games,” which falls within the abstract idea of “methods of organizing human activities.” Ans. 3, 8.

In response, Appellant contends that the claimed invention is patentable subject matter under *Alice*. Reply Br. 3. Appellant contends that “[t]he supposed ‘abstract idea’ in this case has never been specifically identified by the Examiner.” *Id.* Continuing, Appellant contends that “[i]t is improper to state the ‘idea’ as broadly as ‘dice games’ because this analysis, ‘if carried to its extreme, make[s] all inventions un-patentable because all inventions can be reduced to underlying principles of nature.’ *Diamond v. Diehr*, 450 U.S. 175, fn. 12 (1981).” *Id.*

Appellant’s contentions regarding the first step of *Alice* are not persuasive. The Examiner does, in fact, identify an abstract idea. Ans. 3, 8. Also, it is not the Examiner’s position that the abstract idea is “dice games.” Appellant does not apprise us of any error in the Examiner’s position that the abstract idea is “methods of organizing human activities.”

Subsequent to the briefing in this appeal, the Federal Circuit addressed a § 101 rejection of claims directed to a “method of conducting a wagering game.” *In re Smith*, 815 F.3d 816, 817 (Fed. Cir. 2016). In *Smith*, the court stated: “On the first step [of *Alice*], we conclude that Applicants’ claims, directed to rules for conducting a wagering game, compare to other ‘fundamental economic practice[s]’ found abstract by the Supreme Court.” *Id.* at 818. The dice game recited in claim 1 similarly involves wagering (“placing at least one wager” and “paying a payout amount if the at least one wager occurs”). *Smith* also supports the Examiner’s determination that claim 1 is directed to an abstract idea. *See also id.* at 819 (“[W]e conclude

that the rejected claims, describing a set of rules for a game, are drawn to an abstract idea.”).

According to *Alice*, if the claims are determined to be directed to an abstract idea, the second step is to “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S.Ct. 2355 (*quoting Mayo*, 132 S. Ct. at 1298, 1297). The second step is “a search for an ‘inventive concept’ — *i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (*quoting Mayo*, 132 S.Ct. at 1294).

The Examiner determines that the claims do not recite limitations that ensure they are directed to “significantly more” than the abstract idea itself. Ans. 10. Particularly, the Examiner determines that “the introduction of conventional steps pertaining to the rolling of dice does not alter the analysis,” and “the generic implementation of dice is insufficient” to render the claims patent eligible. *Id.*

Appellant responds that the Examiner’s analysis that “the generic implementation of dice is insufficient” fails to consider *each step of each claim*, both individually and as an ordered combination. Reply Br. 4 (emphasis added). This contention is not persuasive.³ Appellant’s contention does not explain why claim 1 recites limitations that ensure it is

³ As Appellant does not argue claims 1–3, 5, 7–14, 16–18, and 23–30 separately, and we have selected claim 1 as the representative claim, we do not consider this contention to the extent it pertains to claims 2, 3, 5, 7–14, 16–18, and 23–30.

directed to “significantly more” than the identified abstract idea itself. In this regard, Appellant does not provide any persuasive argument or evidence to show that the recited steps in claim 1 of “providing a set of dice,” “placing at least one wager,” “rolling the set of dice,” and “paying a payout amount,” considered individually and as an ordered combination, are more than conventional steps or activities in a dice game, and contain an “inventive concept” sufficient to transform the claimed abstract idea into patent-eligible subject matter. *See Alice*, 134 S.Ct. at 2357–58 (“But appending purely conventional steps to an abstract idea does not supply a sufficiently inventive concept.”); *Smith*, 815 F.3d at 819. .

Appellant further contends that the Board routinely reverses rejections under 35 U.S.C. § 101 and, in support, references exemplary Board decisions. Appeal Br. 9–12. However, we need not rely on any of the non-precedential Board decisions referenced by Appellant because the precedential decisions *Alice* and *Smith* support the Examiner’s position.

Appellant also contends that the Patent Office routinely issues patents for casino games that are played in a physical environment, which indicates there is no categorical rule against casino games. Appeal Br. 12–13. Additionally, Appellant contends that the Patent Office has classifications for casino games played in a physical environment, also indicating there is no such categorical rule. Appeal Br. 14. However, the Examiner is not relying on a “categorical rule against casino games,” but rather, relies on precedent. Accordingly, these contentions also are not persuasive.

For the above reasons, we sustain the rejection of claim 1, and claims 2, 3, 5, 7–14, 16–18, and 23–30 falling with claim 1, under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 10, 18, 24, and 26

Appellant's contentions amount essentially to stating what claims 10, 18, 24, and 26 recite and asserting generally that these claims are directed to patent-eligible subject matter based on these recitations. Appeal Br. 14. This is insufficient. *See* 37 C.F.R. § 41.37(c)(iv) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."); *see also In re Lovin*, 652 F.3d 1349, 1356 (Fed. Cir. 2011). Thus, we sustain the rejection of claims 10, 18, 24, and 26 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

*Rejection of claims 1–3, 5, 7–14, 16–18, and 23–30
under 35 U.S.C. § 103(a)*

Claims 1, 3, 5, 9, 11–14, 16, 17, and 23

The Examiner determines that Carroll anticipates claims 1, 3, and 23 except for "the arrangement of indicia on the three dice." Final Act. 5. For claims 1, 3, and 23, and also for claims 5, 9, 11–14, 16, and 17, the Examiner determines that the claimed arrangement of indicia would have been an obvious rearrangement of printed matter, because there is "no new and non-obvious functional relationship to the substrate." *Id.* at 5–6. According to the Examiner, Appellant's "game functions as in the prior art to have player place wagers to predict the occurrence of indicia displayed upon the dice when rolled. [Appellant's] selection and arrangement of indicia and printed matter has not been shown to have any new and non-obvious functional relationships to the dice or game layout." *Id.* at 6.

In support, the Examiner cites to the decision of *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). *Gulack* states, "[w]here the printed matter

is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.”

Gulack, 703 F.2d at 1385. Even if the claimed arrangement for the “first die marking,” “second die marking,” and “third die marking” have some function in the set of dice, “the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *See id.* at 1386 (footnote and citation omitted). The Examiner determines that the claimed die markings (printed matter) are not functionally related to the substrate, and thus, the markings do not distinguish the claimed set of dice from the prior art dice. We agree with the Examiner that Appellant has not established the existence of a new and unobvious functional relationship between the claimed die markings and the dice. Ans. 19. In particular, Appellant has not established that the claimed die markings are interrelated to the dice to an extent that the function of the dice is dependent on the interaction between the die markings and dice.

As Appellant does not apprise us of any error in the Examiner’s findings or reasoning with regard to the rejection of claims 1, 3, 5, 9, 11–14, 16, 17, and 23, we sustain the obviousness rejection of these claims.

Claims 7, 8, and 27–30

For claims 7, 8, and 27–30, the Examiner finds that Carroll discloses or suggests the claimed features. Final Act. 5–6.

Appellant does not provide any specific argument for the rejection of claims 7, 8, and 27–30. As Appellant does not apprise us of error in the Examiner’s findings or reasoning, we sustain the obviousness rejection of claims 7, 8, and 27–30.

Claims 2, 10, 18, and 24–26

The Examiner’s rejection of claims 2, 10, 18, and 24–26 is premised on each claim reciting limitations that are “old and well known.” Final Act. 6.

We agree with Appellant that the Examiner’s rejection is not supported by evidence. Appeal Br. 17. Furthermore, the Examiner does not articulate a reason with a rational underpinning to modify Carroll to result in the subject matter recited in the claims. Accordingly, we do not sustain the obviousness rejection of claims 2, 10, 18, and 24–26.

DECISION

We affirm the rejection of claims 1–3, 5, 7–14, 16–18, and 23–30 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.

We affirm the rejection of claims 1, 3, 5, 7–9, 11–14, 16, 17, 23, and 27–30, and reverse the rejection of claims 2, 10, 18, and 24–26, under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended according to 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED